

### **REMARKS**

Claims 1-26 are currently pending in the subject application. Claims 1, 9, 17, 20, and 22 have been amended herein, while claims 18 and 19 have been canceled. Claims 1 and 17 have been amended to make explicit that which is implicit or inherent in the specification, namely outputting a list of deals in real-time. Thus, no new matter has been added. A clean version of the specification and all pending claims is found at pages 2-6 of this Reply. A version with markings to show amendments made is found at pages 11-13 of this Reply. Favorable reconsideration of the subject application is respectfully requested in view of the comments and amendments herein.

#### **I. Rejection of Claim 22 Under 35 U.S.C. §112, Second Paragraph**

Claim 22 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 22 has been amended herein in a manner believed to overcome the rejection. Accordingly, withdrawal of this rejection is respectfully requested.

#### **II. Rejection of Claims 1-26 Under 35 U.S.C. §103(a)**

Claims 1-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Giovannoli (U.S. 5,842,178). It is respectfully requested that this rejection be withdrawn for at least the following reasons. Giovannoli does not teach or suggest the claimed invention, but rather teaches away from the invention.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Giovannoli fails to teach or suggest outputting a list of deals in real time from amongst the plurality of deals that match the buying criteria of the buyer, as recited by claims 1 and 17. Rather, Giovannoli teaches downloading requests for quotations (RFQs) from users and waiting for vendors to contact the central office FTP site. After the vendor finally contacts the central office, the office acquires information from the vendors product database. Subsequently, the RFQs are processed, and the buyers whose requests were successfully processed are notified *via* email. *See* col. 4, lines 34-52. Thus, the Giovannoli system and methodology fails to teach or suggest expeditious completion of deals *via* outputting a list of deals in real time. Accordingly, the subject invention as recited in claims 1 and 17 is not obvious in view of Giovannoli.

In addition, it is respectfully submitted that Giovannoli teaches away from the real time element of claims 1 and 17.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Moreover, the Federal Circuit has held that teaching away from the art of the subject invention is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

Outputting a list of deals in real time, as recited in claims 1 and 17, is facilitated by storing deals in memory. Giovannoli, however, expressly teaches away from storing deals centrally. *See* col. 1, line 45 through col. 2, line 36, and col. 2, lines 45- 52. Rather, Giovannoli teaches a quotation system that is analogous to a common bidding scheme in which the potential buyer of goods or services requests bids on a particular item or project and awaits submission of offers. The disclosed system together with Giovannoli's condemnation of centrally storing deals would thereby discourages one of ordinary skill in the art from employing real time processes in combination with the present invention as claimed. Thus, it is readily apparent that the claimed invention is not obvious in view of Giovannoli.

Furthermore and as described *supra*, Giovannoli teaches away from storing a plurality of deals for a product offered for sale electronically in memory, and storing a plurality of deals for a

product offered for sale electronically in the central server, as recited in claims 21 and 24 respectively. *See* col. 1, line 45 through col. 2, line 36, and col. 2, lines 45- 52. Accordingly, the subject invention as recited in claims 21 and 24 is not obvious in view of Giovannoli.

With respect to claim 9 and 20, Giovannoli fails to teach or suggest at least one seller outputting a list of deals when a plurality of buying criteria defined by the buyer matches a plurality of selling criteria defined by the seller, and a buyer placing an order on a deal from the seller, the deal being outputted when a plurality of buyer defined buying criteria matches a plurality of seller defined selling criteria, as recited by claims 9 and 20, respectively. Rather, Giovannoli teaches transmitting requests for quotation to the computer network which broadcasts the request for quotation of one more specified standard products to prospective sellers based on filter conditions set by the buyer and/or the seller. Col. 2, lines 46-51. The sellers' offers or deals are latter communicated to the buyer directly or through the quotation system. However, Giovannoli fails to teach or suggest outputting of either a single deal or a list of deals upon the matching of buying and selling criteria. Therefore, the invention as recited in these claims is not obvious in view of Giovannoli.

Claims 2-8, 10-16, 22-23, and 25-26 depend directly or indirectly from claims 1, 9, 21, and 24, respectively. In view of the foregoing, the subject invention as recited in claims 1-17 and 20-26 is not obvious in light of Giovannoli. Reconsideration and allowance of these claims is respectfully requested.

**III. Conclusion**

The present application is believed to be condition for allowance in view of the above amendments and comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,  
AMIN & TUROCY, LLP



Himanshu S. Amin  
Reg. No. 40,894

AMIN & TUROCY, LLP  
24<sup>TH</sup> Floor, National City Center  
1900 E. 9<sup>TH</sup> Street  
Cleveland, Ohio 44114  
Telephone (216) 696-8730  
Facsimile (216) 696-8731

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the Specification:**

Please amend the first full paragraph at page 3 under the heading "Summary of Invention," as follows:

According to a preferred embodiment of the present invention, a multiple criteria buying and selling methodology is provided. The multiple criteria buying and selling methodology is structured to provide buyers and sellers with a variety of information relating to criteria in the purchasing of products to complete a business transaction. By providing the buyers and sellers with a variety of information, the buyers are able to make an informed decision in the buying process relating to each buyer's particular needs, and the seller's are able to control the type of purchases for their goods and services. To facilitate buying and selling products using the multiple criteria buying and selling methodology, an electronic forum is provided whereby buyers and sellers are able to conveniently exchange information and order products.

**In the Claims:**

Please cancel claims 18 and 19 without prejudice or disclaimer.

Please amend claim 1, 9, 17, 20, and 22 as follows:

1. (Twice Amended) A business transaction methodology, including:  
offering a plurality of deals for at least one of a product and service offered by at least one seller;  
inputting a plurality of buying criteria by a buyer for the at least one of a product and service; and  
outputting a list of deals in real time from amongst the plurality of deals that match the buying criteria of the buyer.
9. (Twice Amended) An Internet business transaction system, including:  
a computer adapted to be employed by a facilitator for hosting an Internet based transaction, the computer providing access to at least one buyer and at least one seller to carry out

the commercial transaction, wherein at least one [buyer makes a purchase from the at least one seller] the at least one seller outputs a list of deals when a plurality of buying criteria defined by the buyer matches a plurality of selling criteria defined by the seller.

17. (Twice Amended) A method of conducting a business transaction, comprising:  
electronically offering a plurality of deals on at least one of a product and service for sale, each of said plurality of deals being based on different offering criteria than each other of said plurality of deals;  
electronically searching the deals on the product for sale based on a plurality of ordering criteria;  
outputting a list of deals in real time of the plurality of deals which offering criteria matches the ordering criteria; and  
selecting one of the deals of the list of deals which offering criteria matches the ordering criteria.

20. (Twice Amended) An Internet business transaction system, including:  
a first computer adapted to be employed by a facilitator for hosting an Internet based transaction;  
a second computer adapted to be used by a buyer to link to the first computer to participate in the commercial transaction;  
a third computer adapted to be used by a seller to link to the first computer to participate in the commercial transaction;  
wherein the buyer [makes a purchase from the seller]places an order on a deal from the seller, the deal being outputted when a plurality of buyer defined buying criteria matches a plurality of seller defined selling criteria.

22. (Once Amended) The server of claim 21, wherein the server is configured to provide the plurality of different buyers access to view the at least one of the plurality of deals via one or more of the at least one remote [computes]computers.